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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/428,453	10/28/1999	SATORU MOTOHASHI	35.C13980	4676

5514 7590 06/20/2002

FITZPATRICK CELLA HARPER & SCINTO  
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NEW YORK, NY 10112

EXAMINER
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RODEE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 06/20/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/428,453

Applicant(s)

MOTOHASHI ET AL.

Examiner

Christopher D RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15,22,26,27 and 29-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15,22,26,27 and 29-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Continued Prosecution Application*

The request filed on 21 May 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/428453 is acceptable and a CPA has been established. An action on the CPA follows.

### *Claim Rejections - 35 USC § 112*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 15, 22, 26, 27, and 29-32 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 15, 22, 26, 27, and 29 have been amended and new claims 30-32 presented to include a limitation that the electrophotographic photosensitive member of each device includes in its respective charge transport layer a second polycarbonate having a molecular weight not larger than that of said first polycarbonate resin and fluoroplastic of not less than 1.0 parts by weight and not more than 10.0 parts by weight based on the total weight of the layer. The Examiner has carefully reviewed the specification passages cited by applicants and the specification as a whole but was unable to find basis for the molecular weight of the second polycarbonate, the term "fluoroplastic" without regard to the form of this material, and the precision of the amounts of the fluoroplastic.

Specification page 8 states that the surface charge transport layer has plural kinds of resins having different particle size average molecular weights, and fluoroplastic particles (p. 8, l. 10-14). Preferably the fluoroplastic particles are "1 to 10 parts by weight" of the material of the surface layer (p. 8, l. 15-18). The charge transport layer is formed from a solution containing a blend of polycarbonates (polycarbonate I and polycarbonate II) and fluoroplastic particles (p. 11, l. 16-21). In one embodiment, polycarbonate I has a viscosity-average molecular weight of 5000 and polycarbonate II has a viscosity average molecular weight of 20,000 (p. 12, l. 1-10). These components are used in specified amounts with the fluoroplastic particles. Exemplified fluoroplastic particles are discussed in the passage spanning pages 12 and 13, and again at the top of page 14. In another embodiment 30 to 95 parts by weight of polycarbonate I with a viscosity average molecular weight of 15,000 or less and polycarbonate II with unspecified properties are combined (p. 13, l. 17-22). The examples present specific imaging members for devices, but the characteristics of the resins are not disclosed.

The instant claims do not have basis in the as-filed specification.

The claims include the presence of fluoroplastics that are blended with the other resins but not in particulate form. There is no basis in the specification for this embodiment.

The claims specify a molecular weight relationship of the second polycarbonate to the first polycarbonate that is with basis in the specification. A single embodiment specifies a specific molecular weight for each resin (p. 12, top: polycarbonate I  $M_v = 5000$ , polycarbonate II  $M_v = 20000$ ), but this specific disclosure does not provide basis for all resin combinations where the second polycarbonate has a molecular weight larger than that of the first. Additionally, the noted limitation is not limited to a higher viscosity-average molecular weight and includes other bases (e.g., number-average), which are also not based in the specification.

The instant claims also include a level of precession for the amount of the “fluoroplastic” that is not found in the specification. Values disclosed, such as 1, are accurate to only one significant figure while claimed values, such as 1.0, are accurate to two significant figures. This additional accuracy is not disclosed by the specification.

Claims 31 and 32 are also not based in the specification as filed because there is no disclosure of “a cleaning system” having only the photosensitive member and cleaning blade. The specification also requires the characteristic of the combination to produce scraped particles having an average size of 9.0 microns or less (spec. p. 7, l. 22 – p. 8, l. 2) from the surface of the photosensitive member.

Claims 15, 22, 26, 27, and 29-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims specify a second polycarbonate having a molecular weight not larger than that of said first polycarbonate resin. This limitation is not limited to a higher viscosity-average molecular weight and includes other bases (e.g., number-average, weight-average, etc.). The same resin could give substantially different numerical values for molecular weight based on different averages. It is unclear which average is limiting the “higher” limitation and, thus, the claims are indefinite.

### ***Conclusion***

The previous art rejections are overcome by applicant’s amendments. However, the specification as filed does not provide basis for the claim limitations for the reasons given in the section 112, first paragraph, rejections above.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D RoDee whose telephone number is 703 308-2465. The examiner can normally be reached on most weekdays from 6 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703 308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and 703 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.



**CHRISTOPHER RODEE**  
**PRIMARY EXAMINER**

cdr  
June 17, 2002